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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,117	12/09/2003	Sugio Makishima	2091-0304P	4321
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EXAMINER				
BEMBEN, RICHARD M				
ART UNIT		PAPER NUMBER		
2622				
NOTIFICATION DATE		DELIVERY MODE		
12/10/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/730,117

Applicant(s)

MAKISHIMA ET AL.

Examiner

RICHARD M. BEMBEN

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4 and 6-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 6-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/219,123.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10 October 2008 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 2, 4 and 6-11 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,522,354 issued to Kawamura et al., hereinafter "Kawamura".**

Regarding **claim 1**, Kawamura discloses a digital camera comprising:

display means for displaying digital image data of a photographed image (c. 4, ll. 16-18, c. 5, ll. 32-41 and Figures 2 & 3, "19"), the digital image data having been acquired by photographing and stored as a fixed image data in a storage medium (c. 4, ll. 19-23, 63-67, c. 5, ll. 32-34, Figure 2, "21");

printing-specifying information setting means for setting printing specifying information for said digital image data, the printing specifying information being used during printing (c. 5, ll. 42-46 and Figure 2, selection switches "35", "36" and confirmation switch "37" which specify transfer to printer: c. 6, ll. 36-37);

and control means for displaying said digital image data for which said printing-specifying information was set onto said displaying means so that said printing-specifying information corresponds to said digital image data (c. 6, ll. 51-58 and Figure 6, images 1 and 3 have "PC" icon, which can signify printer) and for

displaying digital image data with no printing-specifying information onto said display means, such that said digital image data for which said printing-specifying information was set and said digital image data with no printing-specifying information are discriminated from each other when they are displayed at the same time on said displaying means (Figure 6, images 1 and 3 have print icon, images 2 and 4-6 do not).

Claim 9 is a method claim corresponding to apparatus claim 1. Therefore, claim 9 is analyzed and rejected as previously discussed with respect to claim 1. Note that claim 9 does not include the limitation to display "at the same time" required by claim 1.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 6, 7, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamura in view of US Pub. No. 2004/0201764 filed by Honda et al., hereinafter "Honda".

Regarding **claim 2**, Kawamura discloses a digital camera comprising a display that displays print information as required by claim 1 (refer to the rejection of claim 1). However, Kawamura does not disclose that said printing-specifying information being used during printing includes a number of print sheets, specification of an index image, printing size, surface treatment, presence of a white frame, trimming and/or attribute data (note that this limitation will be analyzed in the alternative form).

Honda discloses a digital camera comprising a display that displays print information ([0078] and Figures 4, 30A, 30C, 31 & 32A-B) wherein the printing-specifying information being used during printing includes a number of print sheets (Figures 30A, 30C, 31 & 32A-B). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention that the print-specifying information includes the number of print sheets as disclosed by Honda in the digital camera

disclosed by Kawamura such that a user can produce one or several hardcopies of a digital image.

Regarding **claim 6**, Kawamura discloses a digital camera comprising a display that displays print information as required by claim 1 (refer to the rejection of claim 1). However, Kawamura does not disclose that said control means is means for displaying a total number of print sheets on said display means, when said printing-specifying information being used during printing includes a number of print sheets.

Honda discloses a digital camera comprising a display that displays print information ([0078] and Figures 4, 30A, 30C, 31 & 32A-B) comprising a control means for displaying a total number of print sheets on said display means, when said printing-specifying information being used during printing includes a number of print sheets (Figures 30A, 30C & 32A-B disclose total number of print sheets per frame; Figure 31 discloses total number of all frames). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to display the total number of print sheets as disclosed by Honda on the display disclosed by Kawamura such that a user is informed of how many images will be printed.

Regarding **claim 7**, Kawamura discloses a digital camera comprising a display that displays print information as required by claim 1 (refer to the rejection of claim 1). However, Kawamura does not disclose that said control means is means for displaying

a number of print frames onto said display means, when said printing-specifying information being used during printing includes a number of print sheets.

Honda discloses a digital camera comprising a display that displays print information ([0078] and Figures 4, 30A, 30C, 31 & 32A-B) comprising a control means for displaying a number of print frames onto said display means, when said printing-specifying information being used during printing includes a number of print sheets (Figures 30A, 30C & 32A-B disclose total number of print sheets per frame; Figure 31 discloses total number of all frames). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to display the total number of print frame as disclosed by Honda on the display disclosed by Kawamura such that a user is informed which and how many images will be printed.

Claim 10 is a method claim corresponding to apparatus claim 2. Therefore, claim 10 is analyzed and rejected as previously discussed with respect to claim 2.

Regarding **claim 11**, Kawamura discloses the method to operate a digital camera required by claim 9 (refer to the rejection of claim 9). However, Kawamura does not disclose displaying a sum of digital image frames displayed.

Honda discloses a digital camera and method of operating a digital camera comprising a display that displays print information ([0078] and Figures 4, 30A, 30C, 31 & 32A-B) wherein a sum of digital image frames is displayed (Figure 31 discloses total number of all frames). Therefore, it would have been obvious to one of ordinary skill in

the art at the time of the invention to display a sum of digital image frames as disclosed by Honda on the display disclosed by Kawamura such that a user can view the selections he/she made.

7. Claims 4/1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamura in view of Hanzawa (U.S. Patent No. 5,506,661).

Regarding **claim 4/1**, Kawamura discloses a digital camera comprising a display that displays print information (refer to the rejection of claim 1). However, Kawamura does not disclose that control means is means for displaying only the printing-specifying data for which said printing-specifying information was set, in displaying said digital image data onto said display means.

Hanzawa discloses an imaging apparatus comprising a display that displays print information (c. 3, ll. 23-25; c. 4, ll. 40-63; Fig. 2). Hanzawa further discloses that only the printing-specifying data is displayed on said display means (Figs. 2, 5, 6, 8). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to only display print-specifying data as disclosed by Hanzawa on the display means disclosed by Kawamura in order to simplify the display or save power.

Regarding **claim 8**, Kawamura discloses a digital camera comprising a display that displays print information (refer to the rejection of claim 1). However, Kawamura does not disclose that control means is means for displaying a printing price value corresponding to the number of print sheets onto said display means, when said

printing-specifying information being used during printing includes a number of print sheets.

Hanzawa discloses an imaging apparatus comprising a display that displays print information (c. 3, ll. 23-25; c. 4, ll. 40-63; Fig. 2). Hanzawa further discloses that the display displays a printing price value corresponding to the number of print sheets onto said display means, when said printing-specifying information during said printing includes said number of print sheets (c. 4; ll. 40-63; c. 6, l. 3 – c. 7, l. 28; Figs. 2, 5, 6, 8). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to display a printing price value corresponding to the number of print sheets as disclosed by Hanzawa on the display means disclosed by Kawamura in order to inform the customer of the printing price (which is well-known at photo kiosks and the like).

8. Claims 4/2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamura in view of Honda in further view of Hanzawa (U.S. Patent No. 5,506,661).

Regarding **claim 4/2**, Kawamura in view of Honda discloses a digital camera comprising a display that displays print information (refer to the rejection of claim 2). However, Kawamura in view of Honda does not disclose that control means is means for displaying only the printing-specifying data for which said printing-specifying information was set, in displaying said digital image data onto said display means.

Hanzawa discloses an imaging apparatus comprising a display that displays print information (c. 3, ll. 23-25; c. 4, ll. 40-63; Fig. 2). Hanzawa further discloses that only the printing-specifying data is displayed on said display means (Figs. 2, 5, 6, 8). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to only display print-specifying data as disclosed by Hanzawa on the display means disclosed by Kawamura in view of Honda in order to simplify the display or save power.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RICHARD M. BEMBEN whose telephone number is (571)272-7634. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David L. Ometz/
Supervisory Patent Examiner, Art
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RMB